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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,552	03/14/2001	Mark Setteducati	1404	3916

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EXAMINER

MILLER, WILLIAM L

ART UNIT PAPER NUMBER

3677

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicant N .

09/808,552

Applicant(s)

SETTEUCATI, MARK

Examiner

William L. Miller

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 5-16 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-21 and 23-26 is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 22 is/are rejected.
- 7) ☒ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 5-16 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 10.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Russell (US#1473939).
4. Russell discloses an amusement device comprising: an optical prism 5 having an optical front face, and first and second inclined rear faces; a single sheet having a geometric object drawn thereon (Fig. 1), the sheet folded about a central vertical axis to provide left and right halves 3,4 wherein the left and right halves are to be aligned behind adjacent rear faces of the prism (Fig. 2); upon folding the sheet, the left half of the sheet provides a first picture showing a first half of the object in a first position and the right half of the sheet provides a second picture showing the complementary half of the object in a second position; means for mounting the sheet and thus the first and second pictures in alignment with the respective the first and second rear prism faces (page 1, lines 81-91, and page 2, lines 17-19); and whereby a viewer looking through

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the front face of the prism and switching between different angles 6,8 will see whole images (page 1, lines 92-111) of the object.

5. The geometric object is being viewed as having plural positions of movement via the movement between the unfolded position (Fig. 1) of the sheet and the folded position (Fig. 2) of the sheet, and vice versa.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell.

8. Regarding claims 1 and 2, Russell discloses all of the limitations except for the first and second pictures showing first and second halves of a person's face as Russell discloses the first and second pictures showing first and second halves of a geometric object. However, it would have been an obvious design choice to modify Russell by utilizing first and second pictures showing first and second halves of a person's face as patentable novelty cannot be principally predicated on mere printed matter and arrangements thereof, but must reside basically in physical structure. (See *In re Montgomery* 102 USPQ 248).

*Allowable Subject Matter*

9. Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 17-21 and 23-26 are allowed.

11. Regarding claim 17, Russell discloses and/or suggests all of the limitations except for the first and second pictures each defining an area thereon having a respective photo half mounted thereto. It would not have been obvious to one of ordinary skill in the art to modify Russell such that the first and second pictures each defined an area thereon having a respective photo half mounted thereto.

*Response to Arguments*

12. Regarding Russell, the applicant argues the two geometric images on opposite sides of the line of symmetry are not complementary, but unrelated to each other. The examiner disagrees as the two geometric images on opposite sides of the line of symmetry complement and/or cooperate with each other to form the geometric object shown in Fig. 1.

13. Regarding claims 1 and 2, the applicant argues the patentable novelty is not predicated on mere printed matter but on an interaction of printed matter and structure which together provides a synergistic effect. However, Russell provides an interaction of printed matter (drawing of geometric object) and structure (prism 5) which together provides a synergistic effect (page 1, lines 92-111). The fact that the specific design of the printed matter differs in Russell does not yield patentable novelty of applicant's invention as patentable novelty cannot be principally

predicated on mere printed matter and arrangements thereof, but must reside basically in physical structure. (See *In re Montgomery* 102 USPQ 248).

***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Miller whose telephone number is 703 305 3978. The examiner can normally be reached on Tuesday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703 306 4115. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

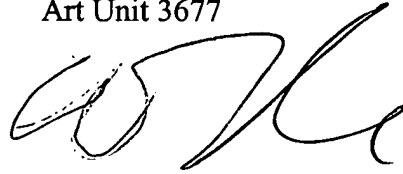
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

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WLM  
10/30/03

William L. Miller  
Primary Examiner  
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A handwritten signature in black ink, appearing to be 'WLM', with a stylized, flowing script.

**WILLIAM L. MILLER  
PRIMARY EXAMINER**